

Application Serial Number 10/517,327

REMARKS / DISCUSSION OF ISSUES

Claims 1-6 are pending. Claims 1, 3 and 5 are independent claims.

Unless indicated to the contrary, claims are amended for non-statutory reasons, for example to replace European-style claim phraseology with American-style claim language. The claims are not narrowed in scope and no new matter is added.

Rejections Under 35 U.S.C. § 103

Claims 1-6 were rejected under one of 35 U.S.C. § 103(a) as being unpatentable over the acknowledged prior art in view of *Sheu* (U.S. Patent 6,593,597). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Analysis of obviousness under 35 U.S.C. §103 requires determination of the scope and content of the prior art, the differences between the prior art, and the claims at issue, and the level of ordinary skill in the pertinent art.

W.L. Gore & Associates, Inc. v. Garlock, Inc. 220 USPQ 303, 311 (1983) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (CAFC 1966)). Moreover, there must have been something present in the teachings of the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W.L. Gore & Associates* at 311 (citing *In re Bergel* 130 USPQ 206, 208 (CCPA 1961); and *In re Sponnoble* 160 USPQ 237, 244 (CCPA 1969)).

Furthermore, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a reason, suggestion or motivation do so. The reason, suggestion or motivation may come from references themselves; from knowledge of those skilled in art that certain references or disclosures in references are known to be of

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interest in the particular field; or from nature of the problem to be solved to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.* 37 USPQ2d 1626 (CAFC 1996). Moreover, prior knowledge in the field must be supported by tangible teachings of reference materials. *Cardiac Pacemakers Inc. v. St. Jude Medical Inc.* 72 USPQ 2d 1333, 1336 (CAFC 2004).

However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability. *Sensonics Inc. v Aerosonics Corp.*, 38 USPQ 2d 1551-1554 (CAFC 1996), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303. Moreover, the determination of obviousness cannot be based on the hindsight combination of components selectively culled out from the prior art to fit the parameters of the claims at issue. *Crown Operations International Ltd. v. Solutia Inc.* 62 USPQ2d 1917, 1922 (CAFC 2002).

Claim 5 is drawn to an integrated circuit and includes:

"...a rectifier circuit coupled between the first node and the second node, the rectifier circuit having a Schottky diode, the Schottky diode comprising a parasitic p/n junction diode..."

Claims 1 and 3 include similar features.

In an embodiment described in the filed application, a rectifier circuit 13 includes a Schottky diode 25. The Schottky diode includes a parasitic p/n junction 26, as may be inferred for the first Schottky diode 21 from Fig. 3. Applicants respectfully submit that the applied art does not disclose at least the rectifier circuit having the Schottky diode with the parasitic p/n junction diode.

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The Office Action turns to Fig. 2A of the reference to *Sheu* for a teaching of the noted features of claims 1, 3 and 5. In particular, the Office Action asserts:

However, the prior art fails to teach or suggest that a rectifier diode of the rectifier circuit takes the form of a Schottky diode with a parasitic p/n junction and wherein the Schottky diode with the parasitic p/n junction forms a second protection diode of the ESD protection circuit.

Sheu teaches a light-emitting diode with electrostatic discharge protection capacity. *Sheu* teaches a first protection diode [Fig. 2A, 30, Fig. 3A] and a second protection diode [Fig. 2A, 40, Fig. 3A] of the ESD protection circuit connected between a power supply [Fig. 2A, V+] and a ground [Fig. 2A, V-] as disclosed in Fig. 2A, Fig. 3A and Col. 5, lines 39-44].

Notably, the reference to *Sheu* discloses a light emitting diode (LED) 30 that is in parallel with a silicon diode 40. This silicon diode 40 provides electrostatic protection for the LED 30. However, the reference fails to disclose a **Schottky diode** as specifically claimed. Furthermore, the reference requires a silicon diode and not a **parasitic p/n junction diode**. In addition, the reference does not disclose that the diode 30 is a protection diode, but rather a diode protected by the silicon diode 40.

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claims 1, 3 and 5. Therefore, a prima facie case of obviousness cannot be properly made based on the relied-upon art. Accordingly, Applicants respectfully submit that the rejections of claims 1, 3 and 5, and the claims that depend therefrom are improper and should be withdrawn.

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Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

NXP

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